

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Attorney Docket № 14989US02)

In the Application of:

Jeyhan Karaoguz, et al.

***Electronically Filed on
30-OCT-2008***

Serial No. 10/675,439

Filed: September 30, 2003

For: METHOD AND SYSTEM FOR
NETWORK STORAGE IN A MEDIA
EXCHANGE NETWORK

Examiner: Kunal N. Langhnoja

Group Art Unit: 2427

Confirmation No. 5630

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicant requests review of the final rejection in the above-identified application, stated in the final Office Action mailed on July 30, 2008 ("Final Office Action") with a period of reply through October 30, 2008. The Applicant also requests review of the arguments stated on page 2 of the Advisory Office Action mailed on October 24, 2008 ("Advisory Office Action"). No amendments are being filed with this request.

This request is being filed with a Notice of Appeal. The review is being requested for the reasons stated on the attached sheets.

REMARKS

The present application includes pending claims 1-31, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-5, 7, 8, 10-15, 17, 18, 20-25, 27, 28, 30, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0135860 ("Dureau") in view of US Patent № 7,065,778 ("Lu"). Claims 6, 9, 16, 19, 26, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dureau in view of Lu, further in view of U.S. Patent Application Publication No. 2003/0066084 ("Kaars"). The Applicant respectfully traverses these rejections at least based on the following remarks.

I. The Proposed Combination of Dureau and Lu Does Not Render Claims 1-5, 7, 8, 10-15, 17, 18, 20-25, 27, 28, 30, and 31 Unpatentable

The Applicant now turns to the rejection of claims 1-5, 7, 8, 10-15, 17, 18, 20-25, 27, 28, 30, and 31 as being unpatentable over Dureau in view of Lu. The Applicant notes that the proposed combination of Dureau and Lu forms the basis for all of the pending rejections.

A. Rejection of Independent Claims 1, 11, and 21

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Dureau and Lu does not disclose or suggest at least the limitation of "converting within said first home, said received media file from said first format to a second format compatible for one or both of presentation and/or playback on a television screen within a second home in a second geographic location," as recited by the Applicant in independent claim 1.

The Final Office Action states the following:

The claimed "converting within said first home, said received media file from said first format to a second format compatible for one or both of presentation and/or playback on a television screen within a second

home in a second geographic location" is met in part by Dureau that discloses the converting of received data by a proxy receiver, 12, from a first format to a second format and the use of any number of receiving devices, 30A-N, including a television for the display of the transcoded data at the same geographic location (Abstract; Figs. 1,2&4; paragraphs [0012J, [0028J, & [0035-0037]). The Dureau reference is silent with respect to the "presentation and/or playback on a television screen within a second home in a second geographic location". However, in the same field of endeavor, the Lu reference teaches the use of a personalized video recorder (PVR) in transmitting recorded media from a first geographic location to a second geographic location for viewing on display device 212 (Abstract; Figs. 2-4; col.2, lines 25-28; col.6, lines 54-58; col. 7, lines 47-53; col.9, lines -20-26; col. 10, lines 10-15, 26-38; col. 11, line 66 to col. 12, line 2; col. 13, lines 47-51; col. 14, line 65 to col. 15, line 2).

See the Final Office Action at pages 3-4. The Examiner concedes that the Dureau reference is silent with respect to the "presentation and/or playback on a television screen within a second home in a second geographic location". However, the Applicant points out that the relevant claim limitation here is **"converting within said first home ... from said first format to a second format compatible for ... presentation and/or playback ... within a second home in a second geographic location."** In other words, the important functionality is "converting" from one format to another format that is used for presentation/playback at a second geographic location. The "presentation/playback" language is related to, and further clarifies, the relevant functionality of "converting", namely the converting is done "for presentation/playback." The Applicant emphasizes that **Dureau is not only silent with respect to the "presentation and/or playback on a television screen within a second home in a second geographic location", but Dureau is also silent and also does not disclose or suggest "converting within said first home ... from said first format to a second format compatible for ... presentation and/or playback ... within a second home in a second geographic location,"** as recited in Applicant's claim 1. **In other words, Dureau does not disclose any format conversion for purposes of presentation/playback in a second location. Even if Dureau is combined with Lu, Lu would not overcome at least this deficiency.**

The Examiner relies on Lu to teach “transmitting recorded media from a first geographic location to a second geographic location.” The Applicant respectfully disagrees as this only partially describes Dureau’s deficiencies. As explained above, Dureau is deficient in not disclosing or suggesting “converting within said first home ... from said first format to a second format compatible for ... presentation and/or playback ... within a second home in a second geographic location.” Lu, including all the citations relied on by the Examiner, does not overcome the above stated deficiencies of Dureau.

Therefore, the combination of Dureau and Lu does not disclose or suggest at least the limitation of “converting within said first home, said received media file from said first format to a second format compatible for one or both of presentation and/or playback on a television screen within a second home in a second geographic location,” as recited by the Applicant in independent claim 1.

Accordingly, the proposed combination of Dureau and Lu does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

The Applicant maintains the arguments stated in pages 15-16 of the September 30, 2008 response, relating to the allowability of the dependent claims.

In general, the Final Office Action makes various statements regarding claims 1-31 and the cited reference that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

II. Conclusion

The Applicant respectfully submits that claims 1-31 of the present application should be in condition for allowance at least for the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Date: 30-OCT-2008

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